

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

KARIN MODELS,
S.A.R.L.

Petitioner,

v.

BRUNEL, JEAN LUC

Registrant.

Cancellation No: 92044040

Registration Nos: 2114051 & 2115957

Marks: KARIN (words only)

KARIN MODELS (and design)

International Class: 035

**RESPONDENT JEAN LUC BRUNEL'S REPLY
TO RESPONSE TO MOTION FOR ENLARGMENT OF
TIME TO RESPOND TO MOTION FOR SUMMARY JUDGMENT**

Respondent, JEAN LUC BRUNEL, by and through his undersigned counsel, hereby files his Reply to Petitioner's Response to Motion for Enlargement of Time to Respond to Motion for Summary Judgment and says:

Petitioner's Response to Motion for Enlargement of Time to Respond to Motion for Summary Judgment continues its attempt to deny needed discovery to BRUNEL. This is an action for cancellation of two registrations. Petitioner urges this Board that there was a prior assignment of the two marks which would prevent the original registrant from assigning the marks to BRUNEL.

BRUNEL is seeking discovery concerning the alleged assignment to Petitioner. The interrogatories and documents requests seek information as to this alleged assignment. However, Petitioner has provided only cursory responses to the requests. For example, Interrogatory No. 10 requested an accounting of the amounts paid under a licensing agreement. Petitioner provides no accounting, but only states that \$20,000.00 was paid. The related Request for Production requests copies of all documents that show the amounts paid. Petitioner objects that the documents would be irrelevant and also claims that there were none. It would seem that one of

these responses would have to be false. There could not have been twenty thousand dollars paid pursuant to the licensing agreement and no record of those payments. BRUNEL suspects that no money was paid as he has not been able to locate any records of any sums being paid. These incompatible responses need to be clarified. Throughout the discovery provided, there are similar incomplete answers which must be addressed.

There is need for further discovery in this case. However, there is a procedure which must be followed. The parties must first attempt to resolve the discovery disputes without intervention by the Board. If that fails, BRUNEL must then file his substantive motions to compel. These matters will certainly not be resolved in ten days.

Further, it is necessary that BRUNEL be able to take the deposition of Petitioner's representative, Etienne des Roys. Petitioner argues that no such deposition is necessary because Etienne's affidavit is only for establishment of a timeline. There is no rule which would limit the deposition to the matters set forth in the affidavit. Des Roys was a witness to the facts and circumstances surrounding the alleged assignment upon which he relies to claim that the registration was invalid. He is also a witness to the notices that were given concerning the later assignment and registration. Des Roys is a fact witness and BRUNEL is entitled to his deposition.

BRUNEL's counsel believed that there was an agreement for Des Roys and BRUNEL to make themselves available for depositions in the State of Florida. If there is no such agreement, then his deposition must be taken on written questions. As BRUNEL's counsel was misled as to how this deposition was going to proceed and has not even begun the process for taking a written question deposition, it is not possible to complete discovery and respond to the Motion for Summary Judgment within ten days.

Petitioner's Motion for Summary Judgment is premature. The parties have not completed discovery. This cause is proceeding under an Amended Petition for Cancellation which was allowed by this Board on November 30, 2005. The Response to the Amended Petition was timely filed on December 23, 2005. Discovery requests by BRUNEL were filed on January 17 and January 20, promptly after the cause was at issue. Petitioner's Motion for Summary Judgment was filed on March 16, 2006, less than four months after the cause was at issue. Considering that Petitioner repeatedly obtained extensions of time to respond to discovery during those four months, and failed to complete the arrangements for the party depositions during those four months, the filing of the summary judgment motion at this stage is an attempt to deny discovery which this Board should not countenance.¹ Petitioner has delayed this case by failing to respond to Interrogatories and a Request for Production of Documents until those responses were seventy-four days past due. This would be understandable if the responses were voluminous or complicated, but a review of the responses show they were cursory, at best, and contain no information that would not have been known to the Petitioner without any research. It is difficult to understand why it took over one hundred days to provide these responses.²

A motion for summary judgment is not a substitute for trial. On its face, there is something peculiar about an assignment of a trademark which is immediately licensed back to the assignor. It is even more problematic when that license agreement provides that a fee will be paid for the license, but there are no records of any payments having been made; there are no

¹ Petitioner also urges this Board in a footnote that BRUNEL has not been cooperative in providing document discovery. No Request for Production of Documents has been served on BRUNEL. Rather, Petitioner's counsel served individuals and companies that were formed after the events described in the Petition to seek documents. It should not be unexpected that these deponents did not have possession of the documents. BRUNEL's counsel has repeatedly urged that to obtain the documents, it is necessary to request them from the party who has possession of them.

² The cursory nature of the responses may well form part of the basis of BRUNEL's Motion to Compel when filed. It would appear from the cursory nature of these responses that the motions to extend were brought in bad faith with the intent to delay this proceeding and, as such, all objections raised well after the time for answering should be deemed waived.

corporate minutes, according to the assignee, relating to either the assignment or the license. Finally, when the assignee is informed that the trademark is being assigned again, it does nothing and allows the assignment to take place. BRUNEL should be allowed the time to complete his discovery. This transaction does not make sense. Perhaps there are legitimate explanations as to why this occurred and why there are such minimal records of what occurred, but considering Petitioner is claiming that the first alleged assignment creates rights superior to the second assignment, Petitioner should be made to provide a full explanation of the events that occurred.

CONCLUSION

The Motion for Summary Judgment should not be ruled on when there are material disputes of fact for which discovery has not been completed. BRUNEL requests that this Court either deny the Motion for Summary Judgment without prejudice, or in the alternative, extend the time for responding to the Motion for Summary Judgment until after discovery is completed. As the filing of the motion has now disrupted the discovery process, BRUNEL also prays that this Court issue a new scheduling order setting new dates for all proceedings in this case, including a time to complete discovery of at least 120 days so that depositions on written questions may proceed.

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By: 

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Fla. Bar No. 0087890

CERTIFICATE OF MAILING

I HEREBY CERTIFY that Registrant's Reply to Response to Motion for Enlargement of Time to Respond to Motion for Summary Judgment is being deposited with the United States Postal Service with sufficient pre-paid postage in an enveloped addressed to: Commissioner for Trademarks, Trademark Appeal and Trial Board, P.O. Box 1451, Alexandria, VA 22313-1451 this 19th day of May, 2006.

By: 

STEVEN ROBERT KOZLOWSKI
Fla. Bar No. 0087890

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a copy of the foregoing Registrant's Reply to Response to Motion for Enlargement of Time to Respond to Motion for Summary Judgment was served on Steven E. Eisenberg, Esq., and Erica W. Stump, Esq., Attorneys for Petitioner, Feldman Gale, P.A., 201 South Biscayne Boulevard, Miami Center-Suite 1920, Miami, FL 33131 by U.S. Mail this 19th day of May, 2006.

By: 

STEVEN ROBERT KOZLOWSKI
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